APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,498	02/09/2001	Hiroshi Yoshida	1095.1157/JDH	5527

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EXAMINER
BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
3639	

DATE MAILED: 05/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/779,498	YOSHIDA, HIROSHI
	Examiner	Art Unit	
	Igor Borissov	3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>20 March 2006</u>.

2a)☐ This action is **FINAL.** 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>14-23</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>14-23</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/20/2006 has been entered.

Response to Amendment

Amendment received on 3/20/2006 is acknowledged and entered. Claims 1-13 have been previously canceled. Claims 14, 17, 19 and 22 have been amended. Claims 14-23 are currently pending in the application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent Claim 14 recites the limitation "...*the circuit information being included in items corresponding to a state of electronic circuits*" in lines 7-8, which is confusing. It is not clear what the terms "items" and "state" actually refer to. Independent Claims 17, 19 and 22 recites same limitation; therefore, same rejections are applied to said independent claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 14 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Tsuchida et al. (US 5,559,997) in view of Takahiro et al. (JP 08297689 A).

Independent claims

Claim 14. Tsuchida et al. (Tsuchida) teaches a system for designing a printed

circuit board, comprising:

Registered noise countermeasure information storing means for storing noise

countermeasure information requested for registration by a registration terminal in the

registration terminal connected via a network (the external storage unit 107, which is a

magnetic disk or the like, stores/registers ... noise reduction component circuit pattern

information) (C. 14, L. 65-C. 15, L. 1);

circuit information acquiring means for acquiring circuit information from a user

terminal connected via the network, which uses the registered noise countermeasure

information, the circuit information being included in items corresponding to a state of

electronic circuits (the circuit information input unit 161 and the component information

input means 162 for receiving circuit and component information including the name,

shape, or electric characteristics of each component, thereby indicating "registering"

feature) (C. 14, L. 45-52);

noise countermeasure information generating means for generating noise

countermeasure information based on said registered noise countermeasure

information and said circuit information, the generated noise countermeasure

information including a plurality of noise countermeasure processes (components and

processes of installing said components) (the external storage unit 107, which is a

magnetic disk or the like, stores ... noise reduction component circuit pattern information) (C. 14, L. 65 - C. 15, L. 1); and transmitting the generated noise countermeasure information to said user terminal (the board design system reads out these different information when the system is started, and displays the designing conditions of the PC board (C. 15, L. 2-7, 15-17);

noise countermeasure information determining means for executing one of the noise countermeasure processes selected by the user from said noise countermeasure information, according to the items, which is required for the noise countermeasure, and transmitting noise countermeasure information which is determined as a result of the execution of the one of the plurality of noise countermeasure processes, to said user terminal (C. 15, L. 66 – C. 16, L. 4).

Tsuchida does not specifically teach that said generated noise countermeasure information including a plurality of noise countermeasure processes includes a *list* of a plurality of noise countermeasure processes.

Takahiro et al. (Takahiro) teaches a system for supporting design of countermeasure against noise, wherein noise countermeasure plan (process) selection part selects the optimum countermeasure plan (process) out of countermeasure plans (processes) displayed on the screen (indicates a *list* of countermeasure plans displayed on the screen) (See from page).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Tsuchida to include that said presented plurality of noise countermeasure processes includes a *list* of a plurality of noise countermeasure processes, as disclosed in Takahiro, because it would advantageously allow to reduce time required for checking the plans (processes) by eliminating repeated work due to trial and error, as specifically stated in Takahiro (Abstract).

Claim 19. Tsuchida teaches said system for designing a printed circuit board, comprising:

a registered noise countermeasure information storing unit for storing noise countermeasure information requested for registration by a registration terminal in the

registration terminal connected via a network (the external storage unit 107, which is a magnetic disk or the like, stores/registers ... noise reduction component circuit pattern information) (C. 14, L. 65-C. 15, L. 1);

a circuit information acquiring unit for acquiring circuit information from a user terminal connected via the network, which uses the registered noise countermeasure information, the circuit information being included in items corresponding to a state of electronic circuits (the circuit information input unit 161 and the component information input means 162 for receiving circuit and component information including the name, shape, or electric characteristics of each component, thereby indicating "registering" feature) (C. 14, L. 45-52);

a noise countermeasure information generating unit for generating noise countermeasure information based on said registered noise countermeasure information and said circuit information, the generated noise countermeasure information including a plurality of noise countermeasure processes (components and processes of installing said components) (the external storage unit 107, which is a magnetic disk or the like, stores ... noise reduction component circuit pattern information) (C. 14, L. 65 - C. 15, L. 1); and transmitting the generated noise countermeasure information to said user terminal (the board design system reads out these different information when the system is started, and displays the designing conditions of the PC board (C. 15, L. 2-7, 15-17);

a noise countermeasure information determining unit for executing one of the noise countermeasure processes selected by the user from said noise countermeasure information, according to the items, which is required for the noise countermeasure, and transmitting noise countermeasure information which is determined as a result of the execution of the one of the plurality of noise countermeasure processes, to said user terminal (C. 15, L. 66 – C. 16, L. 4).

Tsuchida does not specifically teach that said generated noise countermeasure information including a plurality of noise countermeasure processes includes a *list* of a plurality of noise countermeasure processes.

Takahiro et al. (Takahiro) teaches a system for supporting design of countermeasure against noise, wherein noise countermeasure plan (process) selection part selects the optimum countermeasure plan (process) out of countermeasure plans (processes) displayed on the screen (indicates a *list* of countermeasure plans displayed on the screen) (See from page).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Tsuchida to include that said presented plurality of noise countermeasure processes includes a *list* of a plurality of noise countermeasure processes, as disclosed in Takahiro, because it would advantageously allow to reduce time required for checking the plans (processes) by eliminating repeated work due to trial and error, as specifically stated in Takahiro (Abstract).

Claims 15-18 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchida et al. in view of Takahiro et al. and further in view of Robertson et al. (US 6,594,799).

Independent claims

Claim 17. Tsuchida teaches said system for designing a printed circuit board, comprising:

computer apparatus comprising:

registered noise countermeasure information storing means for storing noise countermeasure information requested for registration by a registration terminal in the registration terminal connected via a network (the external storage unit 107, which is a magnetic disk or the like, stores/registers ... noise reduction component circuit pattern information) (C. 14, L. 65-C. 15, L. 1);

circuit information acquiring means for acquiring circuit information from a user terminal connected via the network, which uses the registered noise countermeasure information, the circuit information being included in items corresponding to a state of electronic circuits (the circuit information input unit 161 and the component information input means 162 for receiving circuit and component information including the name,

shape, or electric characteristics of each component, thereby indicating "registering" feature) (C. 14, L. 45-52);

noise countermeasure information generating means for generating noise countermeasure information based on said registered noise countermeasure information and said circuit information, the generated noise countermeasure information including a plurality of noise countermeasure processes (components and processes of installing said components) (the external storage unit 107, which is a magnetic disk or the like, stores ... noise reduction component circuit pattern information) (C. 14, L. 65-C. 15, L. 1); and transmitting the generated noise countermeasure information to said user terminal (the board design system reads out these different information when the system is started, and displays the designing conditions of the PC board (C. 15, L. 2-7, 15-17);

noise countermeasure information determining means for executing one of the noise countermeasure processes selected by the user from said noise countermeasure information, according to the items, which is required for the noise countermeasure, and transmitting noise countermeasure information which is determined as a result of the execution of the one of the plurality of noise countermeasure processes, to said user terminal (C. 15, L. 66 – C. 16, L. 4).

Tsuchida does not specifically teach that:

said system is implemented in a client/server configuration;

said generated noise countermeasure information including a plurality of noise countermeasure processes includes a *list* of a plurality of noise countermeasure processes;

charging control means for performing a charging control process and

identifier transmitting means for transmitting an identifier of the client apparatus.

Takahiro teaches a system for supporting design of countermeasure against noise, wherein noise countermeasure plan (process) selection part selects the optimum countermeasure plan (process) out of countermeasure plans (processes) displayed on the screen (indicates a *list* of countermeasure plans displayed on the screen) (See from page).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Tsuchida to include that said presented plurality of noise countermeasure processes includes a *list* of a plurality of noise countermeasure processes, as disclosed in Takahiro, because it would advantageously allow to reduce time required for checking the plans (processes) by eliminating repeated work due to trial and error, as specifically stated in Takahiro (Abstract).

Robertson et al. (Robertson) teaches a system for facilitating electronic circuit and chip design using remotely located resources, comprising:

a *server* and a *client*, said client is configured to access said server via the Internet (C. 5, L. 1-2; C. 7, L. 58-64; C. 8, L. 24-28);

means for generating a *list* of available tools and services based on user's selection and presenting said list to the user at user terminal (C. 10, lines 19-23, 64-66);

charging control means for performing a charging control process to charge a user for selected items (C. 12, L. 35-36); and

means for transmitting an *identifier* of the client apparatus (a user identification step 401 occurs when the user accesses the portal site 204. Such identification may be accomplished by recognition of a username/password combination, or a "cookie" left on the user system 220, or other means) (C. 15, L. 2-8).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Tsuchida and Takahiro to include that said system is implemented in a client/server configuration, as disclosed in Robertson, because it would advantageously allow to connect electronic designers and design teams and verification tool and service providers through a single portal site (Robertson, C. 5, L. 1-5).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Tsuchida, Takahiro and Robertson to include that said presented plurality of noise countermeasure processes includes a *list* of a plurality of noise countermeasure processes, as disclosed in Robertson, because it would advantageously allow to present said available countermeasure processes in a ranked

order by placing the most suitable choices for the user's design at the top of the listing, thereby simplifying the selecting process for the user (Robertson, C. 11, L. 1-7).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Tsuchida, Takahiro and Robertson to include *charging control means* for performing a charging control process to charge a user for selected items, as disclosed in Robertson, because it would advantageously provide funds for the system to operate.

And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Tsuchida, Takahiro and Robertson to include means for transmitting an identifier of the client apparatus for transmitting a username/password combination, as disclosed in Robertson, because it would advantageously enhance the security of the system and provide the confidentiality of the users' designs.

Claim 22. Tsuchida teaches said system for designing a printed circuit board, comprising:

computer apparatus comprising:

a registered noise countermeasure information storing unit for storing noise countermeasure information requested for registration by a registration terminal in the registration terminal connected via a network (the external storage unit 107, which is a magnetic disk or the like, stores/registers ... noise reduction component circuit pattern information) (C. 14, L. 65-C. 15, L. 1);

a circuit information acquiring unit for acquiring circuit information from a user terminal connected via the network, which uses the registered noise countermeasure information, the circuit information being included in items corresponding to a state of electronic circuits (the circuit information input unit 161 and the component information input means 162 for receiving circuit and component information including the name, shape, or electric characteristics of each component, thereby indicating "registering" feature) (C. 14, L. 45-52);

a noise countermeasure information generating unit for generating countermeasure information based on said registered noise countermeasure information and said circuit information, the generated noise countermeasure information including a plurality of noise countermeasure processes (components and processes of installing said components) (the external storage unit 107, which is a magnetic disk or the like, stores ... noise reduction component circuit pattern information) (C. 14, L. 65-C. 15, L. 1); and transmitting the generated noise countermeasure information to said user terminal (the board design system reads out these different information when the system is started, and displays the designing conditions of the PC board (C. 15, L. 2-7, 15-17);

a noise countermeasure information determining unit for executing one of the noise countermeasure processes selected by the user from said noise countermeasure information, according to the items, which is required for the noise countermeasure, and transmitting noise countermeasure information which is determined as a result of the execution of the one of the plurality of noise countermeasure processes, to said user terminal (C. 15, L. 66 – C. 16, L. 4).

Tsuchida does not specifically teach that:

said system is implemented in a client/server configuration;

said generated noise countermeasure information including a plurality of noise countermeasure processes includes a *list* of a plurality of noise countermeasure processes;

a charging control unit for performing a charging control process and

an identifier transmitting unit for transmitting an identifier of the client apparatus.

Takahiro teaches a system for supporting design of countermeasure against noise, wherein noise countermeasure plan (process) selection part selects the optimum countermeasure plan (process) out of countermeasure plans (processes) displayed on the screen (indicates a *list* of countermeasure plans displayed on the screen) (See from page).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Tsuchida to include that said presented plurality of noise

countermeasure processes includes a *list* of a plurality of noise countermeasure processes, as disclosed in Takahiro, because it would advantageously allow to reduce time required for checking the plans (processes) by eliminating repeated work due to trial and error, as specifically stated in Takahiro (Abstract).

Robertson teaches a system for facilitating electronic circuit and chip design using remotely located resources, comprising:

a *server* and a *client*, said client is configured to access said server via the Internet (C. 5, L. 1-2; C. 7, L. 58-64; C. 8, L. 24-28);

a unit for generating a *list* of available tools and services based on user's selection and presenting said list to the user at user terminal (C. 10, lines 19-23, 64-66);

a *charging control unit* for performing a charging control process to charge a user for selected items (C. 12, L. 35-36); and

a unit for transmitting an *identifier* of the client apparatus (a user identification step 401 occurs when the user accesses the portal site 204. Such identification may be accomplished by recognition of a username/password combination, or a "cookie" left on the user system 220, or other means) (C. 15, L. 2-8).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Tsuchida and Takahiro to include that said system is implemented in a client/server configuration, as disclosed in Robertson, because it would advantageously allow to connect electronic designers and design teams and verification tool and service providers through a single portal site (Robertson, C. 5, L. 1-5).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Tsuchida, Takahiro and Robertson to include that said presented plurality of noise countermeasure processes includes a *list* of a plurality of noise countermeasure processes, as disclosed in Robertson, because it would advantageously allow to present said available countermeasure processes in a ranked order by placing the most suitable choices for the user's design at the top of the listing, thereby simplifying the selecting process for the user (Robertson, C. 11, L. 1-7).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Tsuchida, Takahiro and Robertson to include *a charging control unit* for performing a charging control process to charge a user for selected items, as disclosed in Robertson, because it would advantageously provide funds for the system to operate.

And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Tsuchida, Takahiro and Robertson to include a unit for transmitting an identifier of the client apparatus for transmitting a username/password combination, as disclosed in Robertson, because it would advantageously enhance the security of the system and provide the confidentiality of the users' designs.

Dependent claims

Claim 15. Robertson teaches said system further comprising charging control means for performing a charging control process to charge a user for selected items (C. 12, L. 35-36). The motivation to combine Tsuchida and Takahiro with Robertson would be to provide funds for the system to operate.

Claim 16. Robertson teaches said system wherein said means for charging for selected items comprises means for collecting data on usage of said selected items (C. 9, L. 16-21); said charging means further includes leasing means (C. 5, L. 17-19), thereby indicating charging for said selected items based on said collected data on usage of said selected items. The motivation to combine Tsuchida, Takahiro and Robertson with Robertson would be to provide funds for the system to operate.

Claim 18. Robertson teaches said system wherein said means for charging for selected items comprises means for collecting data on usage of said selected items (C. 9, L. 16-21); said charging means further includes leasing means (C. 5, L. 17-19), thereby indicating charging for said selected items based on said collected data on

usage of said selected items. The motivation to combine Tsuchida, Takahiro and Robertson with Robertson would be to provide funds for the system to operate.

Claim 20. Robertson teaches said system further comprising a charging control unit for performing a charging control process to charge a user for selected items (C. 12, L. 35-36). The motivation to combine Tsuchida, Takahiro and Robertson with Robertson would be to provide funds for the system to operate.

Claim 21. Robertson teaches said system wherein said unit for charging for selected items comprises a unit for collecting data on usage of said selected items (C. 9, L. 16-21); said charging means further includes leasing means (C. 5, L. 17-19), thereby indicating charging for said selected items based on said collected data on usage of said selected items. The motivation to combine Tsuchida, Takahiro and Robertson with Robertson would be to provide funds for the system to operate.

Claim 23. Robertson teaches said system wherein said means for charging for selected items comprises means for collecting data on usage of said selected items (C. 9, L. 16-21); said charging means further includes leasing means (C. 5, L. 17-19), thereby indicating charging for said selected items based on said collected data on usage of said selected items. The motivation to combine Tsuchida, Takahiro and Robertson with Robertson would be to provide funds for the system to operate.

Response to Arguments

Applicant's arguments with respect to claims 14-23 have been considered but are moot in view of the new ground(s) of rejection.
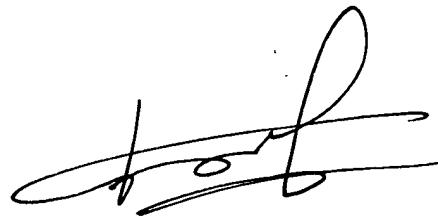
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-

6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IB

5/21/2006

IGOR N. BORISSOV
PRIMARY EXAMINER